

REMARKS

Claims 3 and 6-8 are pending in the present application. No new matter has been presented.

Claim Rejections - 35 U.S.C. §102(e) / 35 U.S.C. §103(a)

Claims 3 and 6-8 are rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Sugino et al.

The Examiner notes that Applicant's arguments filed June 25, 2008 have been considered but are not persuasive. The rejection has been revised but remains essentially the same as the previous rejection.

The Examiner notes Applicant's citation to paragraphs [0048]-[0051] to show that the iodide concentration of Sugino et al. in the stretching step is not anticipatory of the instant range. However, the Examiner notes that paragraphs [0044] and [0045] can be used to anticipate the instant "uniaxially stretching" step, and in these paragraphs, the iodide concentration is disclosed as .05 wt% to 15 wt%, which includes the instantly claimed range. The Examiner concludes that the claimed range remains anticipated by the applied reference.

Applicants respectfully request reconsideration of the rejections for the following reasons.

Applicants note that the present claimed method includes the steps of:

dyeing a polyvinyl alcohol-based film with iodine;
uniaxially stretching the iodine-dyed polyvinyl alcohol-based film in an aqueous boric acid solution containing an iodide at a concentration of 4 to 12% by weight; and

subsequently washing the film with an aqueous solution containing an iodide at a concentration of 0.8 to 2.5% by weight.

Sugino et al. teaches the steps of:

dyeing a polyvinyl alcohol-based film with iodine (paragraphs [0030] – [0035]); uniaxially stretching the iodine-dyed polyvinyl alcohol-based film (during the crosslinking step) preferably in a boric acid solution containing an iodide at a concentration of 1 to 10%, which overlaps the claimed 4 to 12% by weight (paragraphs [0041] – [0045]); and

subsequently washing the film with an aqueous solution containing preferably potassium iodide at a concentration of 1 to 8%.

According to the Manual of Patent Examining Procedure (MPEP) §2131.03,

When the prior art discloses a range that touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case-by-case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute.” What constitutes a “sufficient specificity” is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not

disclosed with "sufficient specificity" to constitute an anticipation of the claims.

In the present claims, the concentration range (0.8 to 2.5% by weight) of the iodide in the washing bath (aqueous iodide solution) in claim 3 of the present invention overlaps the range (1 to 8% by weight) described in paragraph [0048] of Sugino et al. However, the claimed range is not included in the preferred range (3 to 5% by weight) of Sugino (paragraph [0048]).

In addition, in Example 7 (and also in Example 9) of the present invention, the red discoloration by heating is evaluated as "significant red discoloration" when the concentration of the iodide in the washing bath (aqueous iodide solution) was 3% by weight (5% by weight in Example 9). Such result constitutes an unexpected result based on the claimed concentration range (0.8 to 2.5% by weight) of the iodide in the washing bath, compared to the above examples 7 and 9.

Accordingly, it is reasonable to conclude that the claimed narrow range is not disclosed with "sufficient specificity" in Sugino et al. to constitute an anticipation of the claims, and Sugino et al. does not substantially disclose the present invention.

With respect to the rejections under §103, Applicants note that 35 U.S.C. §103(c) indicates that subject matter that qualifies as prior art only under 35 U.S.C. §§102(e), (f), or (g) will not preclude patentability under 35 U.S.C. §103(a) where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Application No. 10/553,958
Attorney Docket No. 053230

Response under 37 C.F.R. §1.116
Response filed January 14, 2009

Applicants note that the assignee of Sugino et al. is Nitto Denko Corporation, to which the subject matter and the claimed invention of the present application were subject to an obligation of assignment at the time the present invention was made.

Therefore, Applicants submit that the present rejections over Sugino et al. under 35 U.S.C. §103(a) should be withdrawn.

In view of the remarks, Applicants submit that the claims are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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